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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,939	11/18/2003	Vitali Victor Lissianski	839-1458	4528
30024	7590	11/17/2004		
NIXON & VANDERHYE P.C./G.E. 1100 N. GLEBE RD. SUITE 800 ARLINGTON, VA 22201			EXAMINER RINEHART, KENNETH	
			ART UNIT	PAPER NUMBER
			3749	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Yw

Advisory Action

Application No.

10/714,939

Applicant(s)

LISSIANSKI ET AL.

Examiner

Kenneth B Rinehart

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11/5/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Response to Arguments

Applicant's arguments filed 11/5/04 have been fully considered but they are not persuasive. First the applicant states that claims 16, and 17 and 29 have been rewritten in independent form. The examiner respectfully disagrees. Limitations have been left out of the claims (the dependent portion of claim 14, for example). Examination on the merits has ended. It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims or add new claims after a final rejection (37 CFR 1.116). Moreover, the applicant has failed to provide good and sufficient reasons why the amendment revising claims 16, 17 and 29 are necessary and were not earlier introduced (37 CFR 1.116(b)). Additionally, in the process of amending the applicant has failed to place the application in better form for appeal by materially reducing the issues for appeal and raised new issues that would require further consideration or search with these new combination of claims. Therefore, the amendment will not be entered. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., mercury released during combustion is captured by carbon rich fly ash generated during the combustion or that the fly ash with captured mercury should be processed to reduce the amount of mercury released to the atmosphere) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. The applicant argues that for Rini to inherently disclose releasing mercury, there must be no way to operate Rini's combustion system without releasing mercury. Additionally the applicant states that the rejection relies on the false legal premise that a purportedly inherent feature of a prior art reference may be relied on to establish obviousness. The examiner responds by stating that coal

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naturally contains mercury and this mercury will be released during combustion. There is no statement in Rini that the coal was processed to remove mercury before the combustion. The disclosure states that Eastern coal was selected for combustion. Consequently, it is inherent that mercury will be released during the combustion in Rini. Next, applicant states there is no finding that a person of ordinary skill in the art would recognize that Rini inherently discloses mercury being released during coal combustion and absorbed on fly ash. The applicant is incorrect in that it is the secondary reference of Pennline which teaches the adsorbing the elemental mercury in the flue gas by the active carbon in the fly ash. The applicant argues that Pennline teaches away from the claimed invention. The examiner disagrees. Penline teaches, among other limitations, "adsorbing the mercury in the flue gas with the fly ash" as claimed. The applicant appears to be arguing against the references individually. It should be noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.


KENNETH F. FINK
PRIMARY EXAMINER